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Paper No. 8

NATH AND ASSOCIATES
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WASHINGTON DC 2005

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In re Reissue Application of: :
Reuser et al. :
Re. Serial No. 10/046,180 :
Filed: January 16, 2002 :
Original Patent No. 6,118,045 :
Original Issue Date: September 12, 2000 :
For: LYSOSOMAL PROTEINS PRODUCED IN THE: :
MILK OF TRANSGENIC ANIMALS :

OFFICE OF PETITIONS

DECISION DISMISSING
PETITION and NOTICE OF
MISSING PARTS

This is a decision on the petitions under 37 CFR 1.47(a), and under 37 CFR 1.181, filed September 18, 2002.

The petition under 37 CFR 1.47 is dismissed as immaterial, and the petition under 37 CFR 1.181 to accept this reissue application in the absence of the assent of all assignees is dismissed. **NOTE THE TIME PERIOD FOR REPLY TO THE NOTICE OF MISSING PARTS INFRA.**

BACKGROUND

The above-noted '045 patent names Reuser, der Ploeg, Pieper, and Verbeet as inventors, and issued to Pharming, Leiden University, Academic Hospital, and Erasmus University, as the joint assignees of the entire interest.

The reissue application papers as filed included an unexecuted declaration and four unexecuted consents of the named assignees of the entire interest. The unsigned declaration stated that the error sought to be corrected by this reissue application is an asserted misjoinder by way of the deletion of Pieper, who, by a conveyance recorded at the USPTO, has assigned his entire rights title and interest in the '045 patent to Pharming.

On March 18, 2002, the Office of Initial Patent Examination (OIPE) mailed a Notice of Missing Parts, indicating, *inter alia*, that the consent of all assignees was present, but had not been signed by all assignees, and that the declaration was likewise unsigned by the named inventors, and that these documents had to be executed.

In reply, on September 18, 2002, applicant filed a four month extension of time, a reissue declaration signed by all the named inventors but Pieper, the written consent of Leiden University, Academic Hospital, and Erasmus University (but not by Pharming), a statement under 37 CFR 3.73(b) signed on behalf of the aforementioned assignees of the part interest (but not by Pharming), a petition under 37 CFR 1.47(a) seeking USPTO acceptance of this reissue application in the absence of Pieper's signature on the declaration, and a petition under 37 CFR 1.181 seeking USPTO processing of this reissue application in the absence of the consent of Pharming required by 37 CFR 1.172 in compliance with 37 CFR §§ 3.71(b)(2) and 3.73.

WITH RESPECT TO THE PETITION UNDER 37 CFR 1.181

Petitioner asserts that the patent technology is undergoing clinical trials, and with commendable candor notes that Pharming will lose all rights if this reissue is permitted to proceed before the USPTO. Petitioner also asserts that the signatory parties to this reissue will suffer irreparable harm if the asserted misjoinder in the patent is not corrected.

However, where a party is an owner only of a part interest in an application, that party does not have the sole right to control prosecution of the application(s). See In re Goldstein, 16 USPQ2d 1963, 1964 (Comm'r Pat. 1988; see also In re Scold, 195 USPQ 335, 335 (Comm'r Pat. 1976); Ex parte Harrison, 1925 Dec. Comm'r Pat. 122, 123 (Comm'r Pat. 1924). The procedures set forth in the regulations serve to assure that papers filed with the USPTO in an application or patent, much less papers that present an application for reissue of a patent, are submitted on behalf of the owners of the entire interest in the application(s) or patent. See Goldstein, 16 USPQ2d at 1964.

The USPTO may not consider a reissue application without the consent of the assignee of the entire interest where a named inventor in the patent is being deleted by the reissue application procedure. See 35 USC 256; 37 CFR 1.172; MPEP 1412.04; Baker Hughes v. Kirk, 921 F.Supp. 801, 38 USPQ2d 1885 (D.D.C. 1995). If all patentees and assignees agree to a proposed change of inventorship in a patent, correction can be had on application to the Commissioner. See 35 USC § 256, first paragraph, and its implementing regulation 37 CFR 1.324. However, in the event consensus is not obtained, as herein, the second paragraph of 35 USC § 256 permits redress in federal court "on notice and hearing of all parties concerned". MCV Inc v. King-Seeley Thermos Co., 10 USPQ2d 1287, 1289 (Fed. Cir. 1989). Thus it would be inappropriate for the USPTO to permit 35 USC 251 to be employed, as here sought,

to circumvent the statutory safeguards set forth in 35 USC 256. See Baker Hughes at 1892; MPEP 1412.04.

Thus, the USPTO may not permit 35 USC 251 to be employed to: (1) make an *ex parte* determination of inventorship, and (2) circumvent the statutory safeguards of 35 USC 256 involving the extinction of an inventor's (or his successor in title's) *pro rata* property right in patented claims. See Baker Hughes, supra. In the absence of Pieper's signature on the declaration and the consent of Pharming, Pieper's successor in title, this reissue application remains incomplete within the meaning of 37 CFR 1.172 and will not be placed on the roles for examination. See 37 CFR 1.53(h). Likewise, as noted in more detail below, 37 CFR 1.47 is not appropriately invoked in this instance. As such, the USPTO will not further proceed with this reissue application. See Baker Hughes, supra. Nevertheless, petitioner may seek relief under either alternate venue noted in more detail below.

WITH RESPECT TO THE IMMATERIAL PETITION UNDER 37 CFR 1.47(a):

It should be noted that 35 USC 116 and its promulgating regulation 37 CFR 1.47(a) operate to protect the property interest of a named inventor by way of USPTO acceptance of a given application in the absence of that inventor's participation in the application. See 35 USC 116 (i.e., "subject to the same rights which the omitted inventor would have had if he had been joined.")

Since petitioner admits that the purpose of this reissue application is to delete Pieper from any reissued patent that might result from this reissue application, petitioner has failed to show how the first sentences of 37 CFR 1.47(a) can be satisfied in this instance. That is, a signing inventor(s) seeking to invoke 37 CFR 1.47 must consider the non-signing inventor to be a **joint inventor**. Since the signing inventors now contend that Pieper is not and never was a joint inventor and seek to delete Pieper as a **joint inventor** and the accompanying declaration(s) does not name Pieper as a **joint inventor**, the record is not clear how this reissue "application may be made by the other inventor [Reuser, der Ploeg, and Verbeet] on behalf of himself or herself and the nonsigning inventor [Pieper]", as required by the regulation. Petitioner has further not shown, nor is it apparent, if Pieper were deleted pursuant to 37 CFR 1.47, how 37 CFR 1.172(b) can be satisfied in this instance. Rather, the latter regulation requires that any reissue patent arising from these reissue applications "will be granted to the original patentee, his legal representatives, or assigns as the interest may appear" which here is Reuser, der Ploeg, Pieper, and Verbeet as inventors,

and Pharming, Leiden University, Academic Hospital, and Erasmus University, as the assigns.

The lack of Pieper's inclusion results in the non-joinder of Pieper, and the extinction of Pharming's rights with respect to all patented claims. Consequently, under the facts of this case, Reuser, der Ploeg, Pieper, and Verbeet as inventors, and Pharming, Leiden University, Academic Hospital, and Erasmus University, cannot logically have the same rights in both the original patent and any granted reissue patent from this reissue application. But see 35 USC 116. As such, petitioner's reliance upon 37 CFR 1.47 is both untenable, and a *non sequitur*.

Where, as here, 37 CFR 1.47 is invoked by the signatory applicants as part of a proceeding to delete a non-joining inventor from an issued patent, tension arises.¹ Manifestly, if an inventor being deleted (or his successor in title) does not agree to the proposed removal, neither can join in, or approve, the filing of the reissue application. Thus, under the circumstances of this reissue application, for the USPTO to treat, much less favorably consider the petition under 37 CFR 1.47 herein, the rights of the non-signing inventor (or his successor in title) would not be protected and that property right extinguished by way of an *ex parte* proceeding without his successor in title's participation or consent. But see Baker Hughes, supra (court holding that USPTO exceeded its authority by deciding to consider via 37 CFR 1.47, without consent of patent assignee, application for reissue filed by co-assignee to remove the other assignee's property right).

ALTERNATE VENUE

Should Pieper and Pharming or any successor to its title consent

¹The Commissioner has no authority under the statute (35 USC 256) to effect a change in inventorship of a patent unless all the named inventors consent in writing. In re RCA Corp., 209 USPQ 1114 (Comm'r Pat. 1981). Pieper, or pursuant to 35 USC 100(d), his successor Pharming, as a co-patentee (and co-assignee), has a vested property right in the original patent that can be canceled, revoked, or annulled only by judicial proceedings that afford due process of law. Iowa State University Research Foundation v. Sperry Rand Corp., 444 F.2d 406, 410, 170 USPQ 374, 377 (4th Cir. 1971). The USPTO may not permit proceedings before it under the reissue statute (35 USC 256) to circumvent the statutory safeguards of 35 USC 256. See Baker Hughes, id.

to the change of inventorship, and all parties are in consensus, petitioner should seek relief under the provisions of 35 USC 256, first paragraph, and 37 CFR 1.324 by filing a request for a Certificate of Correction. See MPEP 1412.04, under the caption "Certificate of Correction as a vehicle for correcting inventorship." Note that this avenue of relief requires, by statute, the consensus of all parties for the USPTO to have jurisdiction, and this requirement of law cannot be waived by the USPTO. See MPEP 1481, under the caption "Correction of Inventor's Names" at 1400-66.(8th Ed., Aug. 2001).

In the event that the consent of both Pieper and Pharming or any successor to Pharming's title cannot be obtained, then the interested parties may wish to seek relief under the provisions of 35 USC 256, second paragraph, before a court of competent jurisdiction as opposed to seeking relief before the USPTO under 35 USC 251. See MCV, supra.

NOTICE TO FILE MISSING PARTS OF NONPROVISIONAL APPLICATION

FILED UNDER 37 CFR 1.53(B)

FILING DATE GRANTED

An application number and filing date have been assigned to this application. The item(s) indicated below, however, are missing.

Applicant is given **TWO MONTHS** from the date of this Notice within which to file all required items and pay any fees required below to avoid abandonment. Extensions of time may be obtained by filing a petition accompanied by the extension fee under the provisions of 37 CFR 1.136(a).

Correction of the following is required to complete this application.

Applicants' reply filed September 18, 2002, to the Notice of Missing Parts mailed March 18, 2002, is incomplete:

Consent of the assignees is missing. 37 CFR 1.172 requires that the reissue oath/declaration be accompanied by the written consent of all assignees. Until the consent of Pharming is supplied, the oath/declaration remains defective. See MPEP 1410.01.

A COPY OF THIS NOTICE MUST BE RETURNED WITH THE REPLY.

This application is being returned to the Office of Initial Patent Examination (OIPE) to await any reply to this Notice.

Further correspondence with respect to this matter should be addressed as follows (see 68 Fed. Reg. 14335 (March 25, 2003)):

By mail: IF MAILED PRIOR TO MAY 1, 2003

Box Missing Parts
Commissioner for Patents
Washington DC 20231

or

U.S. Patent and Trademark Office
P.O. Box 2327
Mailstop Box Missing Parts
Arlington, VA 22202

IF MAILED ON OR AFTER MAY 1, 2003

Mail Stop MISSING PARTS
DIRECTOR OF THE US PATENT AND TRADEMARK OFFICE
PO Box 1450
Alexandria Virginia 22313-1450

Any questions concerning this matter may be directed to the undersigned at (703) 305-1820.



Brian Hearn
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for Patent Examination Policy